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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,152	02/08/2001	Susan L. Acton	MNI-172CP2	4228

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EXAMINER

CHAKRABARTI, ARUN K

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/779,152

Applicant(s)

Acton

Examiner

Arun Chakrabarti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/8/01, 3/2/01, 3/24/01, 10/1/01, 2/1/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 34-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election of claims 1-22, and 34-38, without traverse, in paper number 8, is hereby acknowledged.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

3. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-11, and 30-51 of U.S. Patent No. 6,228,581 B1 (May 8, 2001). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent 6,228,581 B1 clearly teaches a method for determining

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whether a male subject has, or is at risk of developing, an abnormally low HDL level. The male subject species as claimed in U.S. Patent 6,228,581 B1 anticipates the genus subject of the instant claimed invention. Moreover, the SR-B1 gene that is associated with high HDL level as claimed in U.S. Patent 6,228,581 B1 obviously and automatically indicates the status of the SR-B1 gene that is associated with low HDL level.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for the method of determining risk of developing an abnormally low HDL level in any subject associated with the polymorphic region of the SR-B1 gene. Claims 34-38 are rejected because the specification, does not reasonably provide enablement for the method of predicting the effect of hormone replacement therapy on the HDL level in a female subject associated with the allelic variants of the SR-B1 gene. The specification

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does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The Court in *re Wands*, 8 USPQ2d 1400 (CA FC 1988) stated with regard to enablement that

“Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

Here, the claim is broadly drawn to method of determining risk of developing an abnormally low HDL level in any subject associated with the polymorphic region of the SR-B1 gene and the method of predicting the effect of hormone replacement therapy on the HDL level in a female subject associated with the allelic variants of the SR-B1 gene. However, the specification does not provide guidance commensurate in scope with this claim, teaching no example of any association of HDL level in female allelic variants of SR-B1 gene. The specification provides minimal guidance regarding methods for the identification of alternate methodology of any risk factor (abnormal HDL levels) in any subjects of any animal species (including human) associated with the presence of allelic variant of SR-B1 gene other than haplotypes 111, 112, 121, 211, 212, and 221 of three human populations named as

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ASHKENAZI, FINNISH, and SEDISH. There is no working example of any hormone treatment or drug trial and its efficacy in any patients of any animal species (including human) associated with the presence of allelic variant of SR-B1 gene. It is highly unpredictable whether or what other treatments would function in the context of highly variant alleles of SR-B1 genes in different human population and different animal species. It is therefore highly unpredictable whether other diagnostic strategies can be identified which meets this specific criteria regarding the method of determining risk of developing an abnormally low HDL level in any subject associated with the polymorphic region of the SR-B1 gene and the method of predicting the effect of hormone replacement therapy on the HDL level in a female subject associated with the allelic variants of the SR-B1 gene. Further, hormone treatment regiment will be by the trial and error method. This trial and error requirement is borne out because effects of hormone therapy on any disease in any patients of any animal species (including human) associated with the presence of polymorphism cannot be readily deduced, even where the metabolic pathways are known. Further, each disease in any patients of any animal species (including human) associated with the presence of polymorphism has unpredictable effects on metabolic function, and no general method for a priori selection of diagnosis and hormone treatment is presented. It would require a large amount of experimentation, potentially including the synthesis of billions of chemicals (as only human genome consists of 60,000-100,000 polymorphic or variable sites), in order to identify additional metabolic pathways with the claimed functionality. Given the Wand's factors opposing the full scope of enablement including the limited teaching in the specification,

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the presence of only two hypothetical examples, the teaching of unpredictability in the prior art, the unpredictability of the art, the breadth of the claim, and the large amount of experimentation needed, with only the skill level in the art being neutral towards enablement, it is concluded that undue experimentation is necessary to make and use the invention as broadly claimed.

6. Claims 1-22, and 34-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses only six haplotypes which corresponds to the cDNA/genomic DNA encoding the human species associated with the LDL or HDL polymorphism. Claims 1-22, and 34-38 are directed to encompass all gene sequences, sequences that are polymorphic region of the SR-B1 gene corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and so forth. None of these sequences meet the written description provision of 35 USC 112, first paragraph. Moreover, only association of HDL levels with the allelic variant has been demonstrated in man (Figure 7 and page 87, lines 17-19 of the specification). However, no association of HDL level in female allelic variants of SR-B1 gene has been disclosed (Figure 6) in the specification. The specification provides insufficient written description to support the genus encompassed by the claim.

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Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of haplotypes 111, 112, 121, 211, 212, and 221, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that



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"the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli* , 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood* , 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only haplotypes 111, 112, 121, 211, 212, and 221 and man species, but not the full breadth of the claim (or none of the sequences encompassed by the claim) meets the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.)

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 2-20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-20, and 22 recite the limitation "A" in the beginning of each claim. There is insufficient antecedent basis for this limitation in the claim.

#### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D. whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Arun Chakrabarti,

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Patent Examiner,

February 27, 2002

*Arunkr. Chakrabarti*  
**ARUNK. CHAKRABARTI**  
**PATENT EXAMINER**